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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,102	09/26/2001	Anthony J. Baerlocher	0112300-739	3016

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BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,102

Applicant(s)

BAERLOCHER ET AL.

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☒ Claim(s) 20 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 4. 6) ☐ Other: _____

DETAILED ACTION

1. The Preliminary Amendment and Second Preliminary filed on December 4, 2002 and March 6, 2003, respectively, have been received. Currently, claims 1-44 are pending in the application. Acknowledgment has been made.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the display of more than one wild termination symbol of claim 8 and the display of at least two wild symbols of claims 20 and 30 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Claims 20 and 44 are objected to because of the following informalities:

In claim 20, the recited word "in" (line 2) should be changed to "into".

In claim 44, the recited word "having" (line 2) should be changed to "comprising"; further, each limitation must be separated by a semicolon (;) for clarity.

Appropriate correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, the recited term "the player" (line 14) lacks antecedent basis.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 5-7, 9, 10, 12, 13, 16, 17, 19, 21-23, 25-29, 32-34, 36, 37, and 39-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennet (6,089,977).

Bennet teaches a gaming system and method comprising a plurality of reels; a plurality of symbols on said reels; a display device for displaying said reels and at least one of the symbols on each reel (Figs. 1 and 2); a processor in communication with said display (2:45-65), wherein said processor is adapted to selectively determine if one of said plurality of symbols displayed by the display device is a wild activation symbol and if one of said symbols displayed on said reels is a wild termination symbol (upon occurrence of a predetermined triggering event; wherein the wild activation symbol, i.e., an iceberg, appears in the left hand column; and wild termination symbol, i.e., a background coin symbol, appears in the right hand column)(3:1-7); the processor

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transform symbols of the plurality of displayed symbols into wild symbols in a pattern on the display device when the wild activation symbol is determined to be within the display until reaching the symbol determined to be the wild termination symbol; transforming displayed symbols into wild symbols successively (Fig. 3 and columns 3-5); the processor causes the display device to change the determined wild activation symbol into the wild activation symbol and to change the determined wild termination symbol into the wild termination symbol (background coin symbol); the processor is adapted to repeat the determinations (looping while executing game software); the processor randomly determines if one of said symbols displayed by the display device is a wild activation symbol and if one of the symbols displayed on the reels is a wild termination symbol, and transforms at least one displayed symbol into a wild symbol if the processor determines that one of said symbols is a wild activation symbol (1:61-2:6); wherein the displayed symbols are transformed into wild symbols in a pattern from the wild activation symbol to the wild termination position if the processor determines that one of said symbols is a wild activation symbol (upon occurrence of predetermined triggering event); stopping transformations of said symbols into wild symbols based on a position within a display device at which the wild termination symbol is displayed (3:1-55 and 5:35-45); awarding player for any winning combinations (3:25-5:42); and further, applying this to a draw poker machine wherein plurality of card being displayed within the display device (Fig.2; column 2, lines 7-14 and column 5, lines 44-62). See also, Figures 1-3 and columns 1-5.

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8. Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoseloff (6,117,009).

Yoseloff teaches a gaming device comprising a plurality of reels; a plurality of symbols on said reels including at least one natural wild symbol (balloon symbol) (3:49-57); a display device for displaying said reels and at least one symbol on each reel; a processor in communication with said display device, wherein upon an occurrence of a trigger event, if the natural wild symbol (balloon symbol) is displayed on the reels, and the processor transforms said natural wild symbol (balloon symbol), the natural wild symbol (balloon symbol) changes into a modifier which modifies an award provided to a player associated with said displayed symbols (3:51-4:5); the modifier is a multiplier (4:6-27). See also, Figures 1-4 and columns 2-11.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-4, 8, 11, 18, 20, 24, 30, 31, 35, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennet (6,089,977) as applied to claims 1, 5-7, 9, 10, 12, 13, 16, 17, 19, 21-23, 25-29, 32-34, 36, 37, and 39-44 above, and further in view of Schultz (5,332,228).

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Bennet (6,089,977) teaches all limitations of claims 1, 5-7, 12, 13, 16, 17, 19, 21-23, 25-29, 32-34, 36, 37, and 39-44 above. Bennet does not explicitly teach the limitations of: the processor randomly determines which displayed symbols is the wild activation symbol (claim 2); the processor randomly determines which displayed symbols is the wild termination symbol (claim 3); the processor transforms symbols of the plurality of displayed symbols into wild symbols in a random sequence when the wild activation symbols is determined to be within the display device until reaching the symbol determined to be the wild termination symbol (claims 4, 11, 24, and 31); the processor determines if more than one of the symbols displayed on the reels is a wild termination symbol (claim 8); transforming said displayed symbols in a random sequence (claim 18); simultaneously transforming at least two displayed symbols into wild symbols (claims 20 and 30); the processor is adapted to transform cards into wild cards in a random sequence (claims 35 and 38). Schultz, however, teaches a poker game with variable position wild card having a processor operable to randomly determine which displayed symbols is the wild card (3:63-4:6); transform symbols of the plurality of displayed card into wild symbols in a random sequence (4:1-15); transform said displayed card into wild card in a random sequence (3:65-68); simultaneously transform at least two displayed symbols into wild symbols (4:7-15). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Bennet's gaming machine featuring roaming wild card with the technique of randomly transform wild card symbols, as taught by Schultz, to come up with a more

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interesting and excited way to play an electronic gaming utilizing random activation and random termination of wild cards or symbols. See also, Figures 1-7 and columns 3-5.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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